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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/660,211	09/10/2003	Liane Redford	16222U-012710US	6545
66945	7590	11/09/2010	EXAMINER	
TOWNSEND AND TOWNSEND CREW LLP TWO EMBARCADERO CENTER, 8TH FLOOR SAN FRANCISCO, CA 94111			ALVAREZ, RAQUEL	
ART UNIT		PAPER NUMBER		
3688				
MAIL DATE		DELIVERY MODE		
11/09/2010		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/660,211	REDFORD ET AL.	
<b>Examiner</b>	<b>Art Unit</b>		
Raquel Alvarez	3688		

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 23 August 2010.
- 2a) This action is **FINAL**.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-20 and 44-50 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-20, 44-50 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____.
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application
Paper No(s)/Mail Date _____.	6) <input type="checkbox"/> Other: _____.

## DETAILED ACTION

1. This office action is in response to communication filed on 8/23/2010.
2. Claims 1-20, 44-50 are presented for examination.

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 44-48 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Paragraphs 0007 0009 0010 and 0018 merely state “prioritizing multiple coupon redemption for the transaction” but fails to describe how in what way the prioritizing of multiple coupons is being done.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1, 8, 15, 45 provides for the use of “wherein the token acceptance device automatically resolves redemption conflicts associated with a concurrent redemption of the electronic coupon and other coupons”, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is

intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced. For purpose of examination, “other coupons” will be interpret to be other electronic coupons.

Claims 1, 8, 15, 45 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

**Claim Rejections - 35 USC § 102**

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-20, 50 are rejected under 35 U.S.C. 102(b) as being anticipated by Barge et al (WO 95/21428 hereinafter Barge).

With respect to claims 1, 8, 15, 20 and 50 Barge teaches systems and methods for managing redemption under a reward program (abstract).

a portable token configured to store an electronic coupon and a redemption tally, the redemption tally representing the number of times the electronic coupon has been redeemed by a holder of the portable token for a corresponding reward under the

reward program (i.e. customer carried portable device 74 storing electronic coupons and redemption information)(page 3 lines 17 to page 4 lines 1-2) ; and

    a token acceptance device configured to communicate with the portable token and store a redemption limit relating to the electronic coupon, the redemption limit representing the maximum number of times the electronic coupon is allowed to be redeemed for the corresponding reward under the reward program, the token acceptance device further configured to receive information relating to a transaction from the holder (see base device 72)(page 13, lines 22-28);

    wherein the holder indicates to the token acceptance device that the electronic coupon is to be redeemed and applied to the transaction (see Figure 4b, step 162);

    wherein upon receiving indication of redemption of the electronic coupon, the token acceptance device compares the redemption limit to the redemption tally and determines whether the electronic coupon is allowed to be redeemed and applied to the transaction; (see Figure 4b, step 164);

    and wherein the token acceptance device automatically resolves redemption conflicts associated with a concurrent redemption of the electronic coupon and other coupons (i.e. redemption limits that exceeds the redemption amount for the electronic coupon or any other electronic coupon is resolved via on-line mode 190)(page 17, lines 9-57).

With respect to claims 2-3, 9-10, Biorge further teaches a reward host (i.e. an intermediary that oversees all the providers that participate in the incentive

program)(page 6, lines 6-21), configured to allow a reward program sponsor (i.e. provider device 76) to establish the redemption limit and communicate the redemption limit to the token acceptance device and the reward host is further configured to allow the reward program sponsor to change the redemption limit in response to one or more conditions.

With respect to claims 16, 17 Biorge teaches storing the redemption limit in the token acceptance device (see Figure 4b, step 176).

With respect to claims 4, 11, 18-19 Biorge further teaches wherein the redemption limit is established based on one or more criteria that are specific to the holder of the portable token (i.e. different incentives rate based on the customer individual memberships)(page 8, lines 14-20).

With respect to claims 5, 12 Biorge further teaches wherein the portable token includes one of a smartcard card, a cellular phone, a personal digital assistant, a pager, a payment card, a security card, an access card, smart media and a transponder (i.e. customer device 74 can take the form of a processor card or smart card)(page 2, lines 26 to page 3, lines 1-5).

With respect to claims 6, 13 Barge further teaches wherein the token acceptance device includes one of a point-of-sale device, a cellular phone, a personal digital

assistant (PDA), a personal computer (PC), a tablet PC, a handheld specialized reader, a set-top box, an electronic cash register, a virtual cash register, a kiosk, a security system, and an access system (i.e. base device acts a point of sale device)(page 21, lines 6-14).

With respect to claims 7, 14 Barge further teaches if it is determined that the electronic coupon is allowed to be redeemed, the token acceptance device updates the redemption tally of the portable token (see Figure 4b).

**Claim Rejections - 35 USC § 103**

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 44-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barge in view of Official Notice.

Claims 44, 46 and 48 further recite prioritizing multiple coupon redemptions. Official Notice is taken that it is old and well known to rank/arrange or list a group of things in order of priority or importance based on priority. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have used it for

multiple coupon redemptions in order to encourage redemption of the most important coupon first.

Claim 47 further recites storing within the memory of the portable token for use if it determines there is a conflict with other coupons. Official Notice is taken that it is old and well known to store conflicts, problems or the like in a database/memory or the like in order to consult or refer to it at a future day. For example, vendor, business and the like store conflicts/problems in the accounts such as issue of bad checks in the account or the like in order to prevent fraud. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included storing within the memory of the portable token for use if it determines there is a conflict with other coupons in order to obtain the above mentioned advantage.

Claim 49 further recites the portable token being a phone. Barge teaches the portable token being a smartcard. Barge doesn't specifically teach the portable token being a phone. Official Notice is taken that it is old and well known to use cellular phone or the like to store electronic coupons/discounts, etc. in order to provide convenience to the user by allowing the user to receive coupons via already owned device such as the well known cellular phones. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included the portable token being a phone in order to obtain the above mentioned advantage.

**Response to Arguments**

11. Applicant's arguments with respect to claims 1-20, 44-50 have been considered but are moot in view of the new ground(s) of rejection.

**Point of contact**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (571)272-6715. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571)272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Raquel Alvarez/  
Primary Examiner, Art Unit 3688

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Primary Examiner  
Art Unit 3688

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R.A.  
11/5/2010